

REMARKS

Claims 1-18 are pending in the application. Reconsideration and allowance of the claims in light of the amendments and arguments herein is respectfully requested.

Prior art rejection

Claims 1-2, 4, 6-9, 11, 13-14, 16 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US patent number 6,839,420 to Koponen ("Koponen") in view of US patent number 4,899,373 to Lee, et al ("Lee"). Claims 3, 5, 10, 12 and 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Koponen in view of Lee and further in view of US patent number 5,206,899 to Gupta, et al. ("Gupta"). Reconsideration of these rejections is respectfully requested.

Koponen and Lee fail to show all the features of Claim 1

Claim 1 recites "**detecting that a telephone set has been connected to a telephone line,**" and, "**in response to the detection,**" performing several acts, including "**identifying the telephone line,**" "**retrieving a speed dial list,**" and "**communicating the speed dial list associated with the telephone line to the telephone set.**" The act of detecting that a telephone set has been connected to the telephone line starts the processing. At least the **bolded** claim features are missing from the cited references.

Koponen operates differently from the method of claim 1 and fails to show the noted acts. Instead of detecting that a telephone set has been connected to the telephone line, Koponen instead actually requires sending a transfer request from the telephone terminal. Koponen explains at column 2, lines 12-17,

In an embodiment of the method, the transfer of service profile is performed upon start-up of the digital terminal device and/or *upon connection of the digital terminal device to the telecommunication network, in which case the digital terminal device sends a transfer request to the telephone exchange.*
(emphasis added)

Further, Koponen explains at column 2, lines, 40-43,

When the ISDN terminal 3 is connected to the network, the terminal 3 sends to the digital telephone exchange 2 a request to update the service profile. The telephone exchange 2 receives the request and checks the data stored in the telephone exchange 2... (emphasis added)

Thus, Koponen's system actually acts in response to the received request for an updated service profile. In claim 1, instead, further acts occur after detecting that a telephone set has been connected to a telephone line. This operation is different from what Koponen teaches. This claim feature and this capability are missing from Koponen.

Moreover, the missing teaching is not provided by the other cited references. Lee discloses that "data defining a subscriber's personalized set of telecommunication features is temporarily stored in a local exchange in association with any subscriber line on which the subscriber is identified.... The receipt of a subscriber's personal identification number causes the database to be searched and causes the retrieved personalized feature data to be entered in the exchange service the subscriber line from which the personal identification information was received." Column 1, lines 39-52. Again, Lee requires receipt of information and does not operate that a telephone set has been connected to a telephone line" as recited by claim 1.

Further, claim 1 recites "**identifying the telephone line to which the telephone set has been connected,**" and "retrieving a speed dial list ... **wherein the speed dial list is associated in the database with the telephone line.**" Koponen simply fails to disclose any sort of identification of a telephone line used by the disclosed digital terminal device, possibly because the digital terminal device must send an update request, thereby providing some other means of identification. Lee does not associate information with the telephone line identified for the telephone set, but instead associates the data (presumably such as a speed dial list) with the personal identification information provided by the subscriber. Column 1, lines 39-52.

Accordingly, since the prior art of record fails to disclose all the limitations of independent claim 1, it is respectfully submitted that claim 1 is allowable. Claims 2-6 are dependent from claim 1 and add further limitations thereto, and are submitted to be allowable for the same reasons. Withdrawal of the rejections of these claims is respectfully requested.

Koponen and Lee fail to show all the features of Claim 7 as amended

Claim 7 is directed to a method including “receiving a telephone call automatically placed by a telephone set via a telephone line in response to the telephone set being connected to the telephone line, **providing within the telephone call an option to down load a speed dial list, receiving, within the telephone call, a selection of the option to download the speed dial list,**” and “communicating the speed dial list to the telephone set.” The cited references fail to disclose all the features of claim 7.

For example, Koponen and Lee fail to disclose **providing within the telephone call an option to down load a speed dial list**. Claim 7 has been amended to add this feature. No new matter is added by this amendment, which is supported throughout the application, including for example at FIG. 1, item 72 and the associated text. Koponen does not provide such an option. Rather, Koponen instead provides that

the transfer of service profile is performed upon start-up of the digital terminal device and/or *upon connection of the digital terminal device to the telecommunication network, in which case the digital terminal device sends a transfer request to the telephone exchange.* (*emphasis added*)

Column 2, lines 12-17. Thus, Koponen discloses a sort of automatic operation, in which the transfer request is sent by the digital terminal device upon startup of the digital terminal device. Koponen does not provide an option to download a speed dial list or any other information. Further, Koponen operates in response to the received transfer request initiated by the digital terminal device, not in response to receipt of selection of the option to download the speed dial list.

Lee does not provide the missing teaching. Lee discloses detecting existence of a specific string of dialed digits entered by a subscriber upon taking a subscriber line off hook (column 4, lines 20-40). Instead of providing an option within a call and detection selection of the option within the call as recited by claim 7, Lee discloses the subscriber himself initiating the process. The subscriber does not respond to an option, but enters a command, such as the command *TF.

Accordingly, all the limitations of claim 7 are not disclosed by the cited references. Withdrawal of the rejection of independent claim 7 is respectfully requested.

Koponen and Lee fail to show all the features of Claim 8

Claim 8 is directed to “a system comprising a processor to detect that a telephone set has been connected to a telephone line.” “[I]n response to the detection,” several operations of the processor are recited, including “**identify[ing] the telephone line to which the telephone set has been connected,**” “**retriev[ing] the speed dial list from a database based on the identifying, wherein the speed dial list is associated in the database with the telephone line,**” and “communicat[ing] the speed dial list associated with the telephone line.” At least the **bolded** claim features are missing from the cited references. As discussed above in conjunction with the rejection of claim 1, Koponen and Lee, taken alone or in combination, fail to disclose all of these claimed features.

For example, as noted, Koponen and Lee fail to disclose operating “in response to the detection” of the connection of a telephone set to the telephone line. Rather, Koponen requires sending a transfer request from the telephone terminal (column 2, lines 12-17; column 2, lines, 40-43). The feature of operating the processor based in response to the detection is a new feature of the invention defined by claim 8 and is not shown in Koponen or Lee.

Further, these cited references fail to disclose the claim element “**wherein the speed dial list is associated in the database with the telephone line.**” As discussed above, this limitation is not shown in Koponen, which operates in response to a received update request, not a detected connection. Further, Lee does not disclose this feature but instead uses personal identification information to associate a subscriber and data such as a speed dial list.

Accordingly, it is submitted that independent claim 8 is patentable over the cited references, which fail to show or suggest all the limitations of this claim. Claims 9-12 are dependent from claim 8 and are allowable for the same reasons.

Koponen and Lee fail to show all the features of Claim 13

Claim 13 is directed to “a computer-readable medium having computer-readable content to cause a computer to perform acts of: **detecting that a telephone set has been connected to a telephone line,** and, **in response to the detection: identifying the telephone line** to which the telephone set has been connected; **retrieving** a speed dial list from a database **based on the identifying, wherein the speed dial list is associated in the database with the telephone line;**

and communicating the speed dial list associated with the telephone line to the telephone set.”
At least the **bolded** claim features are not disclosed by the cited references, taken alone or in combination.

For example, Koponen and Lee fail to disclose a computer readable medium having computer-readable content to cause a computer to “detect[] that a telephone set has been connected to a telephone line and to operate “in response to the detection” of the connection of a telephone set to the telephone line. Rather, Koponen requires sending a transfer request from the digital data terminal (column 2, lines 12-17; column 2, lines, 40-43). The feature of providing computer readable content to cause a computer to operate in response to the detection is a new feature of the invention defined by claim 13 and is not shown in Koponen or Lee.

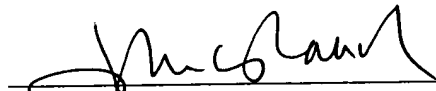
Further, these cited references fail to disclose the claim element “retrieving a speed dial list ... **wherein the speed dial list is associated in the database with the telephone line.**” As discussed above, this limitation is not shown in Koponen, which operates in response to a received update request, not a detected connection. Koponen does not need to make such an association, since Capone’s system provides an update request. Further, Lee does not disclose this feature but instead uses personal identification information to associate a subscriber and data such as a speed dial list.

Accordingly, it is respectfully submitted that independent claims 1, 7, 8 and 13 each recite limitations nowhere shown, described or suggested in the cited references. A rejection under 35 U.S.C. § 103(a) may only be maintained where all limitations are shown or suggested by the prior art. Such is not the case for the invention defined by claims 1, 7, 8 and 13. Accordingly, withdrawal of the rejection of these claims is respectfully requested. The respective dependent claims are submitted to be allowable for the same reasons as the independent claims from which they depend. Withdrawal of the rejection of these claims is respectfully requested as well.

Application no. 10/664,049
Amendment dated: June 26, 2006
Reply to office action dated: February 24, 2006

With this response, the application is believed to be in condition for allowance. Should the examiner deem a telephone conference to be of assistance in advancing the application to allowance, the examiner is invited to call the undersigned attorney at the telephone number below.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "John G. Rauch", written over a horizontal line.

John G. Rauch
Registration No. 37,218
Attorney for Applicant

June 26, 2006
BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200